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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,339	03/28/2005	Shelley Hiron	7865-171 MIS	2858

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/507,339

Applicant(s)

HIRON, SHELLEY

Examiner

Anthony Weier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 8-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reason:

The product may be prepared by a different process utilizing different filtration techniques wherein the protein profile is then adjusted by adding certain proteins to attain the amounts of 2S, 7S, and 12S called for in the instant claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

2. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by either one of "New Technology Isolates Canola Protein" article (henceforth "Food Engineering") or Asia Pacific Industry article (henceforth "Asia Pacific") or rejected under 35 USC 102(b) as being anticipated by GB 2077739.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 9/23/05) in addition to the following. It should be noted that the amended change in protein profile would lead one to consider other sources of soy protein including the discarded supernatant of both Food Engineering, GB 2077739, and the Asia Pacific article. That said, it is expected that the supernatant portion of soy protein

isolate in solution, albeit discarded, would possess the particular protein profile as called for in the instant claims due to the similarity in processing between the instant invention and that set forth in Food Engineering, GB 2077739, and the Asia Pacific article (in creating said supernatant). Furthermore, it should be noted that the soy protein isolate in solution (i.e. supernatant) may be considered a beverage form of the product of the instant invention. With respect to claim 7, it is not seen where the beverage composition being the supernatant itself or a dry mix with added water would make for a patentable distinction since the end product would be the same.

***Claim Rejections - 35 USC § 103***

3. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above.

The claims further call for the protein isolate having a protein content of at least 100%. Although it is expected that the protein content would be the same as called for in the instant claims due to the similarity in processing of same, it would have been well within the purview of a skilled artisan to have purified the protein content, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have attained such value as a matter of preference.

4. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Cameron et al or Murray et al.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 9/23/05) in addition to the following. It should be noted that the amended change in protein profile would lead one to consider other sources of soy protein including the

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discarded supernatant of both Cameron and Murray et al. That said, it is expected that the supernatant portion of soy protein isolate in solution, albeit discarded, would possess the particular protein profile as called for in the instant claims due to the similarity in processing between the instant invention and that set forth in Cameron et al and Murray (in creating said supernatant). Furthermore, it should be noted that the soy protein isolate in solution (i.e. supernatant) may be considered a beverage form of the product of the instant invention. With respect to claim 7, it is not seen where the beverage composition being the supernatant itself or a dry mix with added water would make for a patentable distinction since the end product would be the same.

The claims further call for the protein isolate having a protein content of at least 100%. Although it is expected that the protein content would be the same as called for in the instant claims due to the similarity in processing of same, it would have been well within the purview of a skilled artisan to have purified the protein content, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have attained such value as a matter of preference.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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6. Claims 1-7 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of prior U.S. Patent No. 7,001,990 (previously U.S. Application No. 10/274886).

This is a double patenting rejection.

7. Claims 1-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/384699. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

8. Claims 1-3, 6, and 7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 35-38 of copending Application No. 11/086458. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. Claims 1-3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of copending Application No. 10/493023. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 35-38 of copending Application No. 11/086458 or claims 1-5 of copending Application No. 10/493023.

The claims further call for the protein isolate having a protein content of at least 100%. Although it is expected that the protein content would be the same as called for in the instant claims due to the similarity in processing of same, it would have been well within the purview of a skilled artisan to have purified the protein content, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have attained such value as a matter of preference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

11. Applicant's arguments filed 1/20/06 have been fully considered but they are not persuasive.

Applicant argues that there is no suggestion that the prepared canola protein

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isolate produced in Food Engineering, GB 2077739, Cameron et al, Murray et al, and Asia Pacific article would have the protein profile of the instant claims primarily because the instant invention focuses on an supernatant and the invention of Food Engineering, GB 2077739, Cameron et al, Murray et al, and the Asia Pacific article discard the supernatant and further process micelles. However, it is expected that the supernatant portion of soy protein isolate in solution, albeit discarded, would possess the particular protein profile as called for in the instant claims due to the similarity in processing between the instant invention and that set forth in Food Engineering, GB 2077739, Cameron et al, Murray et al, and the Asia Pacific article.

It should be noted that claims 2 and 3 are only rejected under double patenting. Applicant's arguments have overcome the art rejections previously set forth. More specifically, it should be noted that although prior art discloses the formation of a supernatant, it does not set forth further processing of same. It would not have been obvious to one having ordinary skill in the art at the time of the invention to have modified the supernatant since the references are silent regarding subsequent use of same and actually teach away from further processing as such is considered to be a discarded material.

Applicants argue that there are differences in scope between the instant claims and those involved in the double patenting rejection. The examiner disagrees in that the scope of said claims would essentially cover the same ground. It should be noted as well that although the claims of 11/086458 pertain to the isolate and not a food composition, it is considered to fall within the same scope as the isolate itself may be



considered a food composition.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

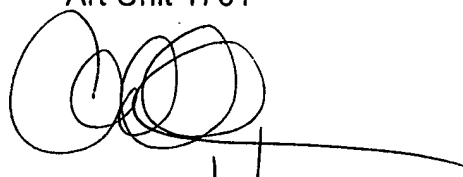
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier  
Primary Examiner  
Art Unit 1761

Anthony Weier  
March 17, 2006



3/17/06